

III. Claim 18 [sic], drawn to a semiconductor element, classified in class 430, subclass 18.

In response to the Restriction Requirement, Applicants elect with traverse, Group I, Claims 1-13.

It is well established that where a single field of search thoroughly covers all of the claims in an application, different classifications in the Patent and Trademark Office should not be controlling. See, for example, M.P.E.P. § 803. The inventions of Groups I and II all have commonality of composition claimed in Group I. Specifically, Group I, Claims 1-13, is drawn to an overcoating composition and Group II, Claims 14-19, is drawn to a process of imaging using the composition of Group I. Therefore, these inventions are so closely related that a proper search of Group I, of necessity, requires a search of Group II. For example, in order to determine whether the compositions of Group I are novel, it is necessary to determine whether these compositions have been previously used or made. Thus, a thorough search for compositions of Group I requires a search for using or making these compositions as well. Therefore, it is submitted that all of the claims can be searched simultaneously without serious burden to the Examiner.

The restriction requirement in this case only serves to increase the prosecution expense to the Applicants and to the Patent and Trademark Office. Therefore, Applicants respectfully request that the restriction requirement be withdrawn.

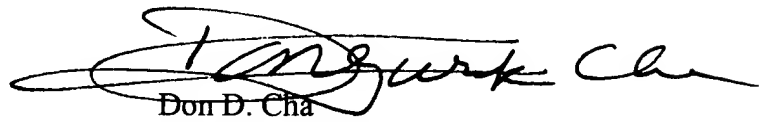
In the event that the Examiner maintains the Restriction Requirement, Applicants request rejoinder of claims of Group II should the claims of Group I are found to be allowable. The law is clear that where product claims and a process of using the product claims are presented in the same application, rejoinder of the process of using the product claims is permitted when the product claim is found allowable. See M.P.E.P. §821.04; *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996); *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995). Thus, when composition claims of Group I are found to be allowable, Applicants request rejoinder of the process for using the composition claims, represented by claims of Group II.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

It is believed that no fees are due with this Response. If any such fees are due, however, then please debit such fees to Deposit Account 20-1430.

Respectfully submitted,


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